

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):

Gardner G. Courson,
Vincent J. Miraglia,
Patrick T. O'Donnell and
Blane A. Erwin

Art Unit: 3629

Serial No.: 10/673,050

Examiner: Janice Mooneyham

Filed: September 26, 2003

Docket No. 230-0002US

For: Method of Early Case Assessment
in Law Suits

Customer No.: 29855

Box Appeal Brief
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Mail Stop: Appeal Briefs – Patents

APPEAL BRIEF

TABLE OF CONTENTS

II.	RELATED APPEALS AND INTERFERENCES.....	4
III.	STATUS OF CLAIMS	5
IV.	STATUS OF AMENDMENTS	6
V.	SUMMARY OF CLAIMED SUBJECT MATTER	7
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	9
VII.	ARGUMENT.....	10
A.	Section 112, ¶ 1 Enablement Rejection.....	10
B.	Section 112, ¶ 1 Utility Rejection	14
B.	Section 112, ¶ 2 Indefinite Rejections.....	18
D.	Section 101 Rejections.....	20
E.	Section 102 Rejections	23
F.	CONCLUSION.....	25
VIII.	CLAIMS APPENDIX.....	27
X.	RELATED PROCEEDINGS APPENDIX.....	31

I. REAL PARTY IN INTEREST

The real party in interest is Legal Tactix, Ltd., the assignee of the present application from three inventors, and is an LLP with Bridgeway Tactix, LLC; Bridgeway Software, Inc. and McGuireWoods, LLP being the partners. Gardner G. Courson, personally may also be a party of interest.

II. RELATED APPEALS AND INTERFERENCES

None

III. STATUS OF CLAIMS

Claims 1-12 are rejected. The appealed claims are 1-12.

IV. STATUS OF AMENDMENTS

None filed

V. SUMMARY OF CLAIMED SUBJECT MATTER

This section provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by paragraph and line number and to the drawings by reference characters as required by 37 CFR § 41.37(c)(1)(v). Each element of the claims is identified with a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

One aspect claimed is a tool for developing litigation discovery materials, the tool comprising:

- an entry field available on a plurality of views not directly related to discovery to request collection of discovery requests; (Discovery Generator button in Figs. 4-100; ¶¶ 9, 53)

- a menu for gathering discovery related information in response to a request using said entry field; (Generate buttons on Fig. 99, drop down box on Fig. 100; ¶¶ 9, 53, 54)

- storage of discovery related information gathered from said menu; (storage 204; Fig. 2; ¶ 29)

- form discovery materials; (¶¶ 9, 53, 54) and

- a discovery production mechanism to combine stored discovery related information and form discovery materials to produce discovery items for use in the litigation. (¶¶ 9, 54)

A second aspect claimed is a tool for recommending a decision in litigation, the tool comprising:

- interfaces for gathering selected information relevant to the decision; (Figs. 6-28; ¶¶ 9, 33-38)

- storage for the gathered selected information; (storage 204; Fig. 2; ¶ 29)

- weighting values associated with each element of selected information; (¶¶ 12, 33, 35, 36, 38)

- an analyzer for using the stored selected information and the associated weighting values to determine a resultant value; (¶¶ 12, 13, 33, 35, 36, 38)

resultant values associated with various decision options; (¶¶ 33, 35, 36, 38) and
a recommendation element using the determined resultant value and the associated
decision options to provide a recommended decision. (¶¶ 15, 33, 35, 36, 38)

A third aspect claimed is a tool for assessing a litigation, comprising:
a plurality of tools according to the second aspect above, each tool for a decision in the
litigation; (¶¶ 33, 35, 36, 38)
interfaces for gathering further selected information relevant to the litigation; (figs. 29-
100; ¶¶ 41-53)
storage for the further selected information; (storage 204; Fig. 2; ¶ 29) and
an assessor utilizing the decisions of each of said plurality of tools and the stored further
selected information for providing an assessment. (¶¶ 30, 36)

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-12 stand rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with enablement; claims 5-12 stand rejected under 35 U.S.C. § 112, ¶ 1 for lack of specific asserted utility or well established utility; claims 1-12 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite; claims 1-12 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and claims 1-12 stand rejected under 35 U.S.C. § 102 as being anticipated by Newell, U.S. Patent Appn. 2003/0112270.

VII. ARGUMENT

The claims do not stand or fall together. Instead, appellants present separate arguments for various independent and dependent claims. After a concise discussion of cited art, each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 CFR § 41.37(c)(1)(vii).

A. Section 112, ¶ 1 Enablement Rejection

The Office Action rejected the claims under various § 112, ¶ 1 Enablement grounds. Applicants respectfully traverse all of them.

For example, in claim 1, the applicant claims a discovery mechanism to combine discovery related information and form discovery materials to produce discovery items for use in litigation. The specification fails to provide an adequate written description of the invention so that one of skill in the art could practice the claimed invention without undue experimentation. The specification does not describe how to combine stored discovery related information and form discovery materials to produce discovery items, what mechanisms are used to make such combination, or how the data or what data is merged in such away as to enable one skilled in the art to make or use the invention.

Applicant's discloses in the specification, paragraph [0054], that the tool selects the particular discovery question and merges them with other form discovery materials. The applicant does not disclose how the tool selects the particular question or how the data is actually merged with other form discover materials. It is not clear what the actually gets incorporated into the materials or what the final product is.

Response:

Applicant directs the Examiner to paragraphs [0009] and [0053-00541]. The Examiner has addressed the arguments along with the cited paragraphs in the rejection above. The applicant states that merging is specifically mentioned as one method of combining discovery related information and form discovery materials. The Examiner asserts that the applicant has failed to disclose how the data is merged.¹

¹ To aid in review of this long and complicated Office Action, Applicants have pasted each rejection and any relevant responses from the Office Action into this brief and then provide arguments to that rejection.

The first rejection relates to claim 1 and the combination of discovery related information and form discovery materials to produce discovery items. Applicants refer to ¶ 9 of the published application² and to ¶¶ 53 and 54. As can be seen, ¶ 9 discusses links to existing document and form production tools and ¶ 54 discusses merging the particular discovery questions with other form discovery materials. Thus merging is specifically mentioned as one method of combining. Other techniques will be readily known to one skilled in the art, based on the particular tool or method used to produce the discovery materials, be it a specialized program or a word processor such as Microsoft Word.

The rejection further requires a description of the mechanism to perform the merger and a description of how the data or what data is merged. As to the mechanism, it is dependent on the existing document and form production tools. Each tool will operate in a specific fashion and any merger mechanism will be based on the specific fashion for each tool. One skilled in the art will readily develop the specific merger mechanism when the operation of the specific tool is stated. As a result, Applicants submit that the present application is sufficiently enabling on this point.

The rejection further requires disclosure of how the particular questions or data are actually merged, what gets incorporated and what the final product is. As to the merger point, again it depends on the particular document and form production tool in use. As discussed above, each will be different but one skilled in the art will readily be able to merge the data when the particular technique of the particular tool is provided. As to what gets incorporated, each document and form production tool will have its own interface for form selection, which would be used for its forms, and then the discovery questions developed from the use of the described Discovery Generator would be merged. As to what the final product is, Applicants reference ¶ 9, which specifically lists Interrogatories and Requests for Production; which, along with depositions, are the prevalent methods of performing discovery in litigation.

The instant specification discloses assigning values to reflect the importance of various aspects of the litigation and a statistical assessment of likely outcomes base on historical records [0014]. However, the actual values used or how the values are assigned or weighted has not been sufficiently disclosed so that one

² All paragraph numbers references to the specification in this response are to the published application.

of skill in the art would know what the values are or how to assign them. Applicant has not disclosed what the values are or what they represent. How does one of skill in the art go about weighting values? How does an analyzer determine a resultant value? What is an analyzer? The term analyzer is not defined in the specification. Is it a person or software? The instant specification does not disclose an equation used to determine the resultant values. Without knowing what the values are or how to weight the values, or how the resultant value is determined, one of skill in the art would simply be left to guess what the values are, how to assign them, and how to determine a resultant value.

Response:

The applicant has not defined any ranges. For the reasons set forth above in the rejection, one skilled in the art clearly would not know how to use the claimed invention. The applicant has not defined the numerical score used to assess the values entered. There is no defined meaning as to the value. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry.

The next rejection relates to claims 5-12 and is apparently based on a perception that the numerical score value must be specifically defined. Applicants traverse the rejection. The illustrated embodiments utilize weighted analysis values to form a score, with the score translated to a recommendation. *See* ¶ 36, particularly at the top of the second column on page 3. The end result of the tool is a recommendation. Any numerical values utilized in the analysis process are internal to the tool itself and are used in the internal calculations and analysis. As such, those numerical values need not necessarily have a specific meaning to a person in the industry. It is sufficient that they have a range and that the range is known so that scores can be converted to recommendations. Further, the actual numerical values would likely vary based on the specific analysis techniques utilized in any event, so again absolute meaning of the specific numeric values is not necessary. Once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then, and is not required to be defined with respect to the outside environments in any event. As an example, consider a series of different surveys. In some cases a ranking of 1 to 5 will be requested. In some of these instances 1 will be high while in others 5 will be high. Other surveys may be 1 to 3 or 1 to 10 or A to E. The actual numerical values are irrelevant. What is relevant is the relationship defined for the particular survey, which then

operates on its own defined values. This survey example indicates the values only have defined meanings within the context of the survey itself, not some universally known value as apparently required by the rejection.

The rejection next questions the weighting values. Applicants quote from ¶ 31: “the actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field.” This is further described in ¶ 36, though the term weighting factors is used. Applicants submit this is extremely clear.

The rejection next questions how the analyzer determines a resultant value. Applicants quote from ¶ 36: “the weighting values are then combined to form a score, which is then translated into a recommendation.” How are they combined? Again that is relevant only to the internal operation of the tool, as the score is then translated into a recommendation. This is clear in the next sentence in ¶ 36: “Again, experienced lawyers would select the scores for a particular recommendation.” Applicants submit this disclosure clearly meets the enablement requirements.

The rejection next questions what is an analyzer, is it a person or software. As the claimed invention is a tool, it is extremely clear that the analyzer is software. See ¶ 29: “Fig. 2 illustrates an exemplary computer system for operating a tool according to the present invention” and “In the preferred embodiment the actual tool runs as a series of Java applications loaded from the server 200 by certain runtime pieces that are installed locally on the workstation 206.”

Applicants submit that the specification is sufficiently enabling when considered by one skilled in the art and reversal of the rejection is requested.

The applicant has identified an invention which requires a user to input information into a computer wherein many of the values are provided by the subjective analysis of the user, an attorney and/or a client. Because the values are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention -to the point that the users become the inventor of their own application of the invention rather than the applicant. Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a

concrete result which can be used by one in the industry other than the person actually entering the information.

The next rejection also relates to claim 5 and a purported subjective interpretation. Applicants traverse this rejection. The rejection is apparently confusing the inputs to the tool used to perform the analysis with the analysis itself. The analysis operates on these subjective values provided by the users. Contrary to the rejection, the analysis will always produce the same result when the same values are provided. Clearly, the analysis might produce different results where different values are provided, but that is the purpose of the analysis, to operate on the values provided to it. Most equations will produce different results when different values are provided. Contrary to the statements of the rejection, the users conduct no experimentation, they simply answer the provided questions in the illustrated embodiments. The recommendation element, embodiments of which are described in ¶ 36, then provides the resulting recommendation. Reversal of the rejection is requested.

B. Section 112, ¶ 1 Utility Rejection

The Office Action rejected the claims under various § 112, ¶ 1 Utility grounds. Applicants respectfully traverse all of them.

The applicant has not defined the numerical score used to assess the values entered. There is no defined meaning as to the value. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry.

Response:

The Examiner asserts that the actual values used or how the values are assigned or weighted has not been sufficiently disclosed so that one of skill in the art would know what the values are or how to assign them. Applicant has not disclosed what the values are or what they represent. How does one of skill in the art go about weighting values? How does an analyzer determine a resultant value? The instant specification does not disclose an equation used to determine the resultant values. Without knowing what the values are or how to weight the values, or how the resultant value is determined, one of skill in the art would simply be left to guess what the values are, how to assign them, and how to determine a resultant value.

The first utility rejection relates to claims 5-12 and is also based on a perception that the numerical score value must be specifically defined. Applicants traverse the rejection. Applicants refer to the remarks above relating to essentially the same rejection for lack of enablement. Applicants submit that the weighting values, score and recommendation do have utility, as is clear from the prior remarks. Applicants request reversal of the rejection is requested.

What is a recommendation element? It is not defined in the disclosure. How is the recommendation decision made using the determined resultant value and the associated decision options? As set forth above, the specification does not describe how this recommended decision is made in such a way as to enable one skilled in the art to make or use the invention.

The next utility rejection relates to claim 5 and the recommendation element and how a recommended decision is made.³ Applicants traverse this rejection. As to the recommendation element, Applicants quote ¶ 36: “The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation.” Thus the recommendation element takes the resultant values, the weighting values in ¶ 36, and combines them to form a score, which is translated to a recommendation, the recommended decision. The particular scores are correlated to a particular recommendation based on input from experienced lawyers. Applicants refer to ¶¶ 35-37 for an example on how a recommended decision is made. As explained for that embodiment, entry or data values are used in a weighted analysis. The weighting values are combined to form a score, which is translated to a recommendation. Other methods are then mentioned, including correlation and statistical decision tree analysis. Applicants thus submit it is very clear what the recommendation element is and how the recommended decision is made. Reversal of the rejection is proper.

As set forth above, the specification does not describe or provide guidance as to the elements of the step or how to perform this step, i.e., determining the

³ Applicants note this appears to be an enablement rejection, not utility rejection, but address it here to remain in the order of the Office Action.

resultant value or recommended decision, in such a way as to enable one skilled in the art to make or use the invention.

The next utility rejection relates to claim 6 on a similar basis as the fifth rejection. Paragraph 36 specifically mentions using prior case results with correlation or statistical decision tree analysis. Applicants quote: “In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately.” Reversal of the rejection is requested.

The specification does not describe how the assessment is performed or what goes into the assessment in such a way as to enable one skilled in the art to make or use the invention.

Response:

However, as set forth in the rejection, applicant has not identified how the data is used in the weighted manner. The applicant has not defined the assessment and the weight value factoring so that one can calculate a recommendation. The applicant has not defined how the recommendation is calculated.

The next utility rejection relates to claim 8 and states that how an assessment is provided is not described.⁴ Applicants traverse this rejection. Applicants first refer to ¶ 30 and Fig. 4. Recommendation 310 is the assessment for the illustrated case. Quoting from ¶ 30: “This is based on the analysis of the collected data and case history review of similar cases and provides a recommendation as to the assessment and procedure for the particular case.” Thus the assessment is the recommendation for the overall litigation, not just a recommendation on one decision or element of the litigation. Paragraph 31 describes an overview of the various steps and states: “Each of these are task and data gathering steps to help develop recommendations. The actual data gathered is used in a weighted manner to help determine the recommendation.” Proceeding then to ¶ 33, which relates to business/venue analysis, it states: “The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool.” Next proceed to ¶¶ 35 and 36, discussed above in more detail, which provide details on removal analysis and also the general analysis techniques and methods used in the illustrated

⁴ Again this appears to be an enablement rejection but is handled in order.

embodiments of the invention. Paragraphs 38 (responsive pleading task), 41 (claim and evidence), 42 (particular termination), 43 (prior charges), 44 (comparator), 45 (decision to terminate) and 50 (damages) discuss further data used in the weighting analysis. See ¶ 49 which states: “Thus, this is a systematic way to gather all of the proof points necessary for the case, with the proof point data being used in the weighting analysis to help determine overall recommendation for the particular case.” Applicants submit that the specification does describe a technique to provide an assessment or overall recommendation of the case and therefore the rejection is improper.

The specification does not describe how to develop the decision tree in such a way as to enable one skilled in the art to make or use the invention.

The applicant has not clearly defined the decision tree in the specification. There is no guidance as to how one of skill in the art would go about developing a statistical decision tree or what input goes into the development of the statistical decision tree.

Response:

As for the decision tree, the Examiner asserts that applicant has not clearly defined the decision tree in the specification. There is no guidance as to how one of skill in the art would go about developing a statistical decision tree or what input goes into the development of the statistical decision tree. Applicant argues that the statistical decision tree is mentioned in paragraph [0036]. Applicant further states that **statistical decision trees and particulars of their development are well known to those skilled in the art and thus are not required to be explained.**

The final utility rejection relates to claims 9-12 and the statistical decision tree. Applicants traverse the rejection. The use of a statistical decision tree is specifically mentioned in ¶ 36. Applicants quote: “In the more complicated situations, such as the full case recommendation shown in Fig. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed from prior case results and/or input from experienced lawyers.” Applicants submit that statistical decision trees and the particulars of their development are well known to those skilled in the art and thus are not required to be explained in detail. A simple search on Google results in thousands of hits, one indicator that the technique is well known. Reversal of the rejection is requested.

B. Section 112, ¶ 2 Indefinite Rejections

The Office Action rejected the claims under various § 112, ¶ 2 grounds. Applicants respectfully traverse all of them.

It is not clear what statutory class the invention falls into. The applicant simply identifies the invention as a tool. However, there is no clear structure identified and there are no clear method steps. For example, claim 1 identifies the invention as comprising an entry field, a menu, storage of discovery related information, form discovery materials, and a discovery production mechanism. A menu and form materials are clearly are not proper structure for an apparatus, but are written data.

The Office Action rejects claims 1-12 under § 112, ¶ 2 for several reasons. First, the Office Action states it is unclear which statutory class the invention falls into. Applicants submit the present claims are properly classified as apparatus or system claims. The present claims are a combination of graphical user interface elements and related data fields (*See* claim 1, entry field and menu), physical storage (*See* claim 1, storage), stored information (form discovery materials), and a generally computer-implemented process (discovery production mechanism). Claims 5 and 8 have similar correlations. Each element clearly falls into the apparatus classification, so the whole invention must then also fall into the apparatus classification.

The Office Action baldly states that a menu and form materials are clearly not proper structure for an apparatus but are written data. The Office Action errs in those points. A menu, particularly the claimed menu which is responsive to a request using an entry field, is clearly a user interface element, which is classically an apparatus element. Form materials are also not just written data but would be stored so that they can be combined by the discovery production mechanism, which is not disputed as being an apparatus. Thus those elements are sufficient so that it is clear that the claim is for an apparatus.

Claim 5 is directed to a tool for recommending a decision in litigation comprising interfaces, storage, weighting values, an analyzer, resultant values and a recommendation element. Weighting values appears to be a method step. Resultant values are not structure. Therefore, it is unclear what statutory class the applicant's invention resides in.

Claim 8 is directed to a tool for assessing a litigation comprising a plurality of tools, interfaces, storage, and an assessor. The applicant fails to identify what an assessor is in the specification.

What does the applicant mean by "a tool"?

NOTE: The applicant defines "a tool" in the arguments submitted on June 21, 2006 as something (as an instrument or apparatus) used in performing an operation or necessary in practice of a vocation or profession).

Second, the Office Action requests a definition for "a tool." As noted in the Office Action, Applicants are using normal meaning for the term. For example, tool as a noun is defined as "something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession" in Webster's Ninth New Collegiate Dictionary. When the specification and claims are reviewed, Applicants submit that their use of the word is consistent with that definition, an ordinary meaning of the word "tool." The Office Action provided no response to this argument, simply adding the note which appears to answer the question. Applicants submit that the rejection is improper.

What does the applicant mean by the following language in claim 1 - *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

Third, the Office Action requests clarification of the phrase "an entry field" in claim 1. Again Applicants responded in the June 21, 2006 response and the Office Action failed to address the response. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled "Discovery Generator." Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the "Discovery Generator" button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described embodiment and is not to limit the meaning of the claim term to that specific example.

What does the applicant identify as an analyzer?

Fourth, the Office Action requested identification of an “analyzer.” Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here. Again, this response was previously provided and not addressed.

Claim 8 identifies the invention as “a tool”. However, the body of the claim language states that there are a plurality of tools according to claim 5. This is unclear.

Fifth and finally as to the indefiniteness rejections, the Office Action is confused by the use of “tool” for both claim 5 and claim 8 which incorporates claim 5. Applicants repeat these remarks from the prior response, which also was not addressed by the Office Action. Claim 5 defines a singular tool according to the present invention, a tool to recommend a particular decision in a litigation. Claim 8 uses a plurality of the singular tools of claim 5 to assess a litigation. Thus claim 8 utilizes the various decisions provided by the plurality of tools of claim 5 used as elements in claim 8 to provide an assessment of the litigation. As an analogy, if claim 5 were to claim a wrench, then claim 8 would include a plurality of the wrenches of claim 5. The claim format, while unusual, is proper and Applicants submit that the rejection should be reversed.

D. Section 101 Rejections

The Office Action rejected the claims on various § 101 grounds. Applicants respectfully traverse all of them.

It is not clear what statutory class the applicant's invention would fall into. The applicant identifies the invention as a tool. There does not appear to be sufficient structure identified. For example, in claim 1, the applicant states that the tool comprises an entry field, a menu, form discovery materials and a discovery production mechanism. Thus, the invention is not clearly a machine or system. The applicant does not clearly define method steps although such language as set forth in claim 1 could be construed to be a method step (storage of discovery related information gathered from said menu). Therefore, the invention does not clearly fall into the statutory class of process or method. It is not an article of manufacture or a composition of matter. Therefore, the invention appears to be non-statutory.

NOTE: In applicant's remarks submitted with the amendment filed on June 21, 2006, applicant states that the claims are properly classified as apparatus or system claims. The applicant states that the present claims are a combination of graphical user interface elements and related data fields, physical storage, stored information, and a generally computer implemented process (page 9). Stored information is not structure.

Data fields are not structure.

Claim 5 is directed to a tool comprising interfaces, storage, weighting values, an analyzer, resultant values, and a recommendation element. Weighting values appears to be a method step. Resultant values is not structure or method steps. It is unclear what a recommendation element is or what an analyzer is.

Claim 8 is a tool comprising a plurality of tools, interfaces, storage, and an assessor. Once again, it is unclear what statutory class of the invention would fall into.

Furthermore, it is not clear whether the tool is software or a web site or web pages. Claims drawn to web sites or web pages require careful analysis. It should be determined whether such a claim is drawn to a collection of files or to computer or network hardware.

According to common definitions and barring any "special definition" in an application, web sites or web pages are files or documents, not the computer or network hardware that makes available or presents these files. The MPEP gives us guidance on how to deal with files or documents at MPEP 2106 IV B 1 (a) and (b), under the headings of "functional descriptive material" and "nonfunctional descriptive material".

If the files or documents are data structures or computer executable code, they are statutory if they are embodied on a computer-readable medium, provided of course they provide a useful, concrete and tangible result. If the files or documents are nonfunctional descriptive material, e.g. music, photographs, compilations of data, such material cannot exhibit any functional interrelationship with the way in which computing processes are performed and would not be statutory. This is true even if the nonfunctional descriptive material is embodied on a computer-readable medium.

The first § 101 rejection was based on non-statutory subject matter. Applicants submit this rejection has been addressed above with the § 112, ¶ 2 rejection, where it was clearly illustrated the present claims are properly apparatus claims. The Office Action makes various remarks about data fields not being structure and files or documents being functional or non-functional descriptive material. The common error in these remarks, in particular, and in the § 112, 2nd paragraph and § 101 rejections on this point in general, is that the citations and

rejections are based on rules and policies relating to the claim as a whole, not to individual elements. It is clear that it is the claim as a whole that must be reviewed. One cannot simply find one element and declare the claim non-statutory on that basis, which appears to be the approach taken in the Office Action.⁵ This further is the case when the allegedly non-statutory elements are utilized in or products of other clearly statutory elements.

Claims 5-12 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.

In the present case, the values are subjective. Furthermore, the decision tree identified in claims 9-12 is developed with input from experienced lawyers. Thus, because the values and input are subjective, for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

The second § 101 rejection is based on a requirement that the invention produce a useful, concrete and tangible result and a confusion about the use of subjective values in the invention.

⁵ Indeed, under the procedure used in the Office Action, even the claims expressly hold statutory in *Diamond v. Diehr* would be considered nonstatutory.

1. A method of operating a rubber-molding press for precision molded compounds with the aid of a digital computer, comprising:

- providing said computer with a data base for said press including at least,
 - natural logarithm conversion data (ln),
 - the activation energy constant (C) unique to each batch of said compound being molded, and
 - a constant (x) dependent upon the geometry of the particular mold of the press,
- initiating an interval timer in said computer upon the closure of the press for monitoring the elapsed time of said closure,
- constantly determining the temperature (Z) of the mold at a location closely adjacent to the mold cavity in the press during molding,
- constantly providing the computer with the temperature (Z),
- repetitively calculating in the computer, at frequent intervals during each cure, the Arrhenius equation for reaction time during the cure, which is
$$\ln v = CZ + x$$
where v is the total required cure time,
- repetitively comparing in the computer at said frequent intervals during the cure each said calculation of the total required cure time calculated with the Arrhenius equation and said elapsed time, and
- opening the press automatically when a said comparison indicates equivalence.

While Applicants believe this has been addressed under the § 112, ¶ 1 Enablement and Utility rejections, Applicants again note that the Office Action is confusing input data with the operation of the invention. For a given set of input data, the invention will always produce the same result, a useful, concrete and tangible result, for claim 5 a recommendation and for claim 8 an assessment. Different inputs may well produce different results, but such is generally true.

Applicants submit that the § 101 rejections are improper and should be reversed.

E. Section 102 Rejections

Claims 1-12 were rejected under § 102 over Newell. Applicants traverse the rejections.

Referring to Claim 1:

Newell discloses a tool for developing litigation discovery materials, comprising:
an entry field (Figure 1a (103), [0056];
a menu (Figure 3A);
storage ([0024-0029];
forms (Figure 3B-2 Common Case Forms);
production mechanism [0100].

Referring to Claims 2-4:

Newell discloses the menu includes information relating to discovery type and party [0030-0031].

Referring to Claims 5-12:

Newell discloses a tool for aiding in litigation, comprising:
interfaces [Figure 1a (103)) ;
storage [0024-0029];
an analyzer (processor unit 112).

Response:

The Examiner asserts that since applicant states that the claimed invention is directed to an apparatus, then the data stored or input into the structure would be non-functional descriptive data, not functionally related to the structure of the invention. A data entry field would be an interface. The data displayed would not be functionally related to the structure. A menu is a display of data. The intended use of the menu is given little patentable weight if the apparatus or system of Newell is capable of having a menu. Storage is storage of data, generally a database. What is stored in the database is non-functional descriptive data. Form discovery materials are not considered to be structure. Weighted values are not considered to be structure. Thus, the Examiner asserts that as applicant has

claimed applicant's invention, Newell applies as prior art and applicant's claim language does not distinguish from the prior art.

With the above-description and explanation of the claims, Applicants submit that it is readily apparent that numerous elements of the claims are missing in the Newell reference, when all of the elements are properly considered.

Claim 1

Applicants first note that Newell is not related at all to developing discovery materials. Newell is simply a litigation management system, a hyperlinked database of all of the information and materials in the litigation. It only contains previously developed material. That said, it is clear that Newell does not contain “an entry field available on a plurality of views not directly related to discovery to request collection of discovery requests” nor “a discovery production mechanism to combine stored discovery related information and form discovery materials to produce discovery items for use in the litigation.” The Office Action does not refute these points in citing portions of Newell. It simply deletes most of the language of each element, which language clearly distinguishes it from Newell. Applicants specifically note that the two specific examples mentioned as distinguishing Newell, the entry field and the discovery production mechanism, are not elements which were the basis of the § 112 or § 101 rejections. Therefore, there was no valid basis for simply ignoring most of the language of the claim elements. Even discounting all of the other elements, Newell clearly does not teach or suggest those two elements. Thus, even given the response in the Office Action, there is no basis for the rejection.

Claim 5

Applicants here note that Newell is not related at all to recommending a decision in litigation, Newell being merely a hyperlinked database of case information. As such, Newell does not disclose any of the claim elements starting at “weighting values associated with each element of selected information.” Applicants also note that the Office Action has failed to even make a prima facie rejection. In addition to ignoring most of the element language, as done with claim 1, it has failed to even cite an element in Newell which corresponds to the claimed recommendation element. Thus the rejection is improper on its face and must be reversed.

Claim 8

Applicants here again note that Newell is not related at all to assessing a litigation, Newell being just a hyperlinked database. As such, Newell clearly does not disclose the “plurality of tools according to claim 5, each tool for a decision in the litigation” or “assessor utilizing the decisions of each of said plurality of tools and the stored further selected information for providing an assessment.” Indeed, as above in the rejections of claims 1 and 5, most of the language in each element has been omitted. And, similar to claim 5, the Office Action has failed to even cite an element in Newell corresponding to the assessor element in claim 8. So again the rejection is improper on its face and must be reversed.

Office Action Response

The Office Action did provide some response to Applicants’ arguments on the § 102 rejections. Most of the remarks related to defining which elements would not be considered structure, and thus apparently would be omitted from the rejection. Applicants submit that this approach is improper, particularly as the elements are proper as discussed above repeatedly. Applicants note that even then the rejections are inconsistent with this improper approach. First, the approach would not justify omitting most language in each element, which language was never mentioned as being improper. Yet this was done, as discussed above. Second, the approach would not justify totally omitting elements never mentioned as being improper, as was done in the rejections of claims 5 and 8, as noted above. Thus the rejections are inconsistent even with the improper remarks, further reason for the rejections to be reversed.

Applicants therefore submit that the § 102 rejections are improper and must be reversed.

F. CONCLUSION

For the reasons stated above, Applicants respectfully submit that the rejections should be reversed. Applicants believe that they have complied with each requirement for an appeal brief. If any member of the Board of Appeals has any questions or otherwise feels it would be advantageous, he or she is encouraged to telephone the undersigned at (832) 446-2405.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This

discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

A three month extension fee is believed proper. Such fees should be charged to Wong, Cabello, Lutsch, Rutherford & Brucculeri, LLP Deposit Account Number 501922, referencing matter number 250-0002US. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Wong, Cabello, Lutsch, Rutherford & Brucculeri, LLP Deposit Account Number 501922, referencing matter number 250-0002US.

Respectfully submitted,

/Keith Lutsch/

March 8, 2007

Filed Electronically

Keith Lutsch, Reg. No. 31,851
Wong, Cabello, Lutsch,
Rutherford & Brucculeri, L.L.P.
20333 SH 249, Suite 600
Houston, TX 77070
832-446-2405

VIII. CLAIMS APPENDIX

1. (Original) A tool for developing litigation discovery materials, the tool comprising:
an entry field available on a plurality of views not directly related to discovery to request collection of discovery requests;

a menu for gathering discovery related information in response to a request using said entry field;

storage of discovery related information gathered from said menu;

form discovery materials; and

a discovery production mechanism to combine stored discovery related information and form discovery materials to produce discovery items for use in the litigation.

2. (Original) The tool of claim 1, wherein said menu includes information related to discovery type, relevant party and a discovery request.

3. (Original) The tool of claim 2, wherein said form discovery materials include materials for a plurality of discovery types and said discovery production generation mechanism determines a desired discovery type and combines stored discovery related information and form discovery materials for the desired discovery type.

4. (Original) The tool of claim 3, wherein said discovery production mechanism further determines a relevant party for selected discovery types and combines stored discovery related information and form discovery materials relevant only to the relevant party.

5. (Original) A tool for recommending a decision in litigation, the tool comprising:
interfaces for gathering selected information relevant to the decision;
storage for the gathered selected information;
weighting values associated with each element of selected information;
an analyzer for using the stored selected information and the associated weighting values to determine a resultant value;

resultant values associated with various decision options; and
a recommendation element using the determined resultant value and the associated decision options to provide a recommended decision.

6. (Original) The tool of claim 5, further comprising:
a collection of results of the decision in prior litigation and the selected information for those litigations; and
wherein one of said analyzer and said recommendation element utilize said collected results to develop a resultant value or recommended decision.

7. (Original) The tool of claim 5, further comprising:
an output indicating the amount of selected information that has been gathered.

8. (Original) A tool for assessing a litigation, comprising:
a plurality of tools according to claim 5, each tool for a decision in the litigation;
interfaces for gathering further selected information relevant to the litigation;
storage for the further selected information; and
an assessor utilizing the decisions of each of said plurality of tools and the stored further selected information for providing an assessment.

9. (Original) The tool of claim 8, wherein said assessor includes a statistical decision tree.

10. (Original) The tool of claim 9, wherein said statistical decision tree is developed with prior litigation results and the decisions and further selected information for the litigation.

11. (Original) The tool of claim 9, wherein said statistical decision tree is developed with input from experienced lawyers.

12. (Original) The tool of claim 11, wherein said statistical decision tree is further developed with prior litigation results and the decisions and further selected information for the litigation.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.